

REMARKS/ARGUMENTS

Claim 3 has been cancelled and claims 1, 2, 4, and 5 have been amended. Applicant notes that amended claims 1, 2, 4, and 5 are fully supported by the application as filed. For example, the Applicant respectfully directs the Examiner's attention to the specification at page 3, line 27; page 4, line 23.; Figure 1; and Figure 2. Upon entry of the above amendments and the following remarks, claims 1, 2, 4, and 5 will be pending in the present application.

Claim Rejections Under 35 U.S.C. §102

Claims 1-3 have been rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,837,972 to Padilla, wherein it is asserted that Padilla teaches each of the claimed limitations. Applicant respectfully notes that the rejection of claims 1-3 appears to be based on United States Patent No. 5,530,225 to Hajaligol, since the Examiner's statement in paragraph 2 of the Detailed Office Action appears to be inconsistent with the Padilla reference.

Applicant further notes that the proper standard under 35 U.S.C. §102 for finding anticipation is that the prior art must disclose each and every limitation found in the claims, either expressly or inherently. Rockwell International Corp. v. United States, 147 F.3d 1358, 1363 (Fed. Cir. 1998); Electro Med System S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994). Furthermore, the omission of any claimed element no matter how insubstantial is grounds for traversing a rejection based on 35 U.S.C. §102. Connell v. Sears Roebuck & Co., 772 F.2d 1542 (Fed. Cir. 1983).

Rejection of Claim 3

Applicant has cancelled claim 3 without prejudice to filing in a later application. As such, any proper rejection under 35 U.S.C. §102 has been obviated.

Rejection of Claim 1

Claim 1 has been rejected under 35 U.S.C. §102 as being anticipated by both the Hajaligol and Padilla references. Applicant respectfully directs the Examiner's attention to the Padilla reference. In particular, Padilla fails to disclose, at least, a device wherein the central and outer portions are substantially cylindrical and comprise intermeshing elongate fingers that slide upon one another as the curler is reconfigured. In addition, the Hajaligol reference fails to disclose, at least, a central portion including a heating element. In contrast, the Hajaligol discloses a heating element 122 "deposited on heater blade 120." Hajaligol, column 12, lines 25-26. As such a proper rejection under 35 U.S.C. §102 of amended claim 1 cannot be made.

Claims 1 and 2 Are Non-Obvious Under a Proper 35 U.S.C. §103 Analysis

The claimed invention is additionally non-obvious with regard to Hajaligol and Padilla since there is at the minimum no suggestion or motivation present in the teachings of Hajaligol and Padilla, or within the knowledge of one of ordinary skill in the art as evidenced by, at least, the references cited in the Office Action, to do what the Applicant has done in the claimed invention. For example, at a minimum Hajaligol and Padilla do not teach or suggest that central and outer portions are substantially cylindrical and comprise intermeshing elongate fingers that slide upon one another as the curler is reconfigured wherein the central portion includes a heating element. Applicant notes that as thoroughly discussed in a recent court holding:

"...the essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d

1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors)." In re Lee, 61 USPQ2d, 1430 (Fed. Cir. 2002)

Such a rigorous examination, as required by law, clearly would find the claimed invention non-obvious based on at least a study of the problem to be solved by the Applicants, and the functionality of the claimed invention. For example, Applicant's claimed invention, among other things, "overcomes or substantially ameliorates" the disadvantages associated with hair curlers. Specification, page 1. In stark contrast, the Hajaligol is directed toward smoking devices. For example, see Hajaligol, columns 1 and 3.

The Hajaligol Reference is Nonanalogous Art For the Purpose of Rejections Under 35 U.S.C. §103

MPEP §2141(a) states that for an examiner to rely on a reference under 35 U.S.C. §103, the reference must be analogous art. As summarized by the courts, "[I]n order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor is concerned". In re Oetiker, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

Rejection of claims 4 and 5 under 35 U.S.C. §103 with reference to the Hajaligol reference is improper for at least the reason that the Hajaligol reference is directed toward a different field of endeavor than the Applicant's claimed invention and is not pertinent to the particular problem with which the Applicant is concerned. Simply stated, a person of ordinary skill in the art would not reasonably have expected to solve, at least, the problems associated with hair curling with a reference directed toward the combustion of smoking materials. The Hajaligol disclosure explicitly teaches "generating smoke from a tobacco medium". Hajaligol, column 3, lines 33-34. Hajaligol accomplishes this combustion by heating the heater blades of the Hajaligol device to a temperature of 800 to 900 degrees Celsius. Hajaligol column 12, line 24. Clearly, the

Hajaligol reference is directed toward a different field of endeavor than the Applicant's.

Furthermore, even if the Hajaligol reference is considered in the same field as the Applicant's invention, which it is not, the Hajaligol reference is directed toward an endeavor (generating smoke from a tobacco medium) that would not logically have "commended itself to an inventor's attention in considering his problem" (curling hair with a hair roller). In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992) See also Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858 (Fed. Cir. 1993). For at least these reasons the Hajaligol reference is nonanalogous art, and as such cannot be relied on as a reference by the Examiner in this case.

Rejections Under 35 U.S.C. §103

Claims 4-5 has been rejected under 35 U.S.C. 103 as "being unpatentable over Hajaligol in view of United States Patent No. 3,593,724 to Leal".

Applicant respectfully notes that in order to properly establish a *prima facie* case of obviousness, the Examiner must meet three basic criteria. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP §2143.

Cited Prior Art Fail to Teach or Suggest All Claimed Elements

Amended claims 4 and 5 depend directly on amended claim 1. As such, claims 4 and 5 are patentable for at least the reason the Hajaligol and Leal references fail to teach or suggest central and outer portions which are substantially cylindrical and comprise intermeshing elongate fingers that slide upon one another as the curler is reconfigured wherein the central portion

includes a heating element. Applicant respectfully draws the Examiners attention to Hajaligol Figures 4A-4D and Hajaligol column 11, line 31 to column 12 line 11. Hajaligol requires that the heater blades 120 and the heater sinks 220 be adjacent one another for proper smoke generation. Hajaligol column 4 lines 3-24. Clearly, the Hajaligol reference does not disclose intermeshing elongate fingers that slide upon one another as the curler is reconfigured (to alter an overall length of the hair curler) since reconfiguring the Hajaligol device would expose the tobacco material directly to the heating blade. As such a proper rejection under 35 U.S.C. §103 cannot be made.

The Proposed Modification or Combination Would Change the Principle of Operation of Hajaligol

The MPEP states that “[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)” MPEP 2143.01.

As discussed above, the Hajaligol reference requires that the heater blades 120 and the heat sinks 220 be adjacent one another for proper smoke generation. Hajaligol column 4 lines 3-24. In providing the Hajaligol device with intermeshing elongate fingers that slide upon one another as the curler is reconfigured (to alter an overall length of the hair curler) would clearly expose the tobacco material directly to the heating blade without benefit of the heat sink. This would clearly change the principle of operation as taught and suggested by Hajaligol. Because of, at least, these reasons the rejection of the claims under 35 U.S.C. §103 is improper.

Cited Prior Art Teach Away

It is a well-established “general rule” that references which teach away cannot serve to create a prima facie case of obviousness. In re Gurley, 27 F3d

551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994). A "reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the Applicant." Winner Int'l Royalty Corp. v. Wang, 202 F.3d 1340 (Fed. Cir. 2000) citing Gurley at 553; Monarch Knitting Machinery v. Sulzer Morat GmbH, 139 F.3d 877, 882 (Fed. Cir. 1998).

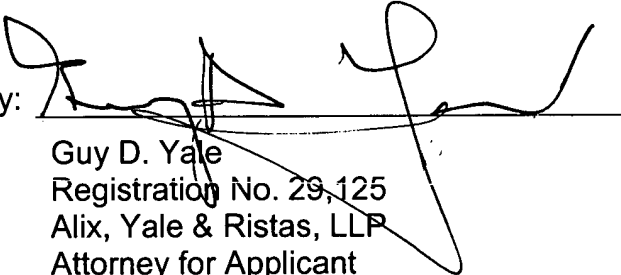
The Hajaligol disclosure expressly teaches and suggests a line of development flowing toward an electrical smoking article. See Hajaligol title and Hajaligol reference generally. For example, the Hajaligol device is configured to heat tobacco materials to a combustion temperature. Hajaligol, column 3, lines 31-44. This clearly is a line of development unlikely to be productive in achieving, for example, the advantages to hair curling using rollers wherein there are intermeshing elongate fingers that slide upon one another as the curler is reconfigured, and wherein the central portion includes a heating element as sought by the Applicant. As such, the Hajaligol disclosure clearly teaches away from the claimed invention. Therefore, the rejection under 35 U.S.C. §103 is improper for at least this additional reason.

In summary, the Applicant has addressed each of the rejections within the present Office Action. It is believed the application now stands in condition for allowance and prompt favorable action thereon is earnestly solicited.

Respectfully Submitted,

Kin Man Wong

By:



Guy D. Yale
Registration No. 29,125
Alix, Yale & Ristas, LLP
Attorney for Applicant

Date: September 2, 2004
750 Main Street, Suite 1400
Hartford, CT 06103-2721
(860) 527-9211
Our Ref: MCHK/144/US

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